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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,683	06/07/2000	Katsutoshi Ushida	862-C1923	9220
5514	7590	10/06/2003	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			ENGLAND, DAVID E	
		ART UNIT	PAPER NUMBER	
		2143	3	
DATE MAILED: 10/06/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/588,683	USHIDA, KATSUTOSHI
	<b>Examiner</b>	<b>Art Unit</b>
	David E. England	2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 February 2001 .
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-100 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

1. Claims 1 – 100 are presented for examination.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3, 9, 10, 26, 32, 33, 53, 56, 58, 59, 65, 76, 88 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “the most common one” is a relative term that makes these claims indefinite.

3. Claims 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “switched on the bases” is ambiguous in the interpretation of its function of turning on an operation panel or changing, (i.e. swapping), information.

4. Claims 22, 23, 45, 49, 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "most likely" in claim 22, 23, 45, 49, 50 are relative term which renders the claim indefinite. The term " most likely " is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 – 4, 7 – 15, 23, 25 – 27, 30 – 33, 34 – 38, 42, 43, 45 – 67, 71, 72, 82, 84 – 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joffe et al. (6600750) (hereinafter Joffe) in view of Applicant's admitted prior art.

7. As per claim 1, Joffe teaches a communication apparatus comprising:

means for transmitting/receiving electronic mail data by connecting to the Internet, (e.g. col. 1, line 16 – col. 2, line 57); and Applicant discloses as admitted prior art, means for communicating the electronic mail data having facsimile-format image data attached by performing communication pertaining to functional information in addition to the communication of the electronic mail data, (e.g. page 1, line 13 – page 3, line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Applicant's admitted prior art with Joffe because it would be more convenient for a system to transmit an email data having facsimile-format image data attached through the Internet to a users computer to save on a disk, rather than have to go from fax device to fax device.

8. As per claim 2, Joffe teaches a communication apparatus comprising:

9. first connecting means for connecting to a local area network and/or second connecting means for connecting to a wide area network, (e.g. col. 1, line 16 – col. 2, line 57);

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10. first communicating means for transmitting/receiving electronic mail data by connecting to the Internet by one of said first and second connecting means, (e.g. col. 1, line 16 – col. 2, line 57); and
11. second communicating means for performing facsimile communication by connecting to the wide area network by said second connecting means, (e.g. col. 1, line 16 – col. 2, line 57 & Fig. 3), and Applicant admits in the prior art wherein communication concerning functional information is performed when said first communicating means communicates electronic mail data having image data attached, (e.g. page 1, line 13 – page 3, line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Applicant's admitted prior art with Joffe for similar reasons stated above.
12. As per claim 3, as interpreted by the Examiner, Applicant admits in the prior art if there is no response to the communication concerning functional information from a communication partner apparatus with which said first communicating means communicates, electronic mail data is sent to said first communicating means by attaching image data corresponding to the most common one of image data standards, (e.g. page 1, line 13 – page 3, line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Applicant's admitted prior art with Joffe for similar reasons stated above.
13. As per claim 4, as interpreted by the Examiner, Joffe teaches if there is no response to the communication concerning functional information from a communication partner apparatus with which said first communicating means communicates and if communication by said second communicating means is designated and the number of the other party is designated, said second communicating means communicates image data, (e.g. col. 1, line 16 – col. 2, line 57 & col. 4, line 13 – col. 5, line 35).
14. As per claim 7, as interpreted by the Examiner, Joffe teaches if a communication error occurs during the communication by said first communicating means, electronic mail data describing information concerning

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communication error information is transmitted to said communication partner apparatus or a previously designated electronic mail address, (e.g. col. 2, line 30 – col. 3, line 62).

15. As per claim 8, as interpreted by the Examiner, Joffe teaches wherein if a communication error occurs during the communication by said first communicating means, electronic mail data having image data attached is transmitted to said communication partner apparatus or to a previously designated electronic mail address, (e.g. col. 2, line 30 – col. 3, line 62).

16. As per claim 9, as interpreted by the Examiner, Joffe teaches wherein if a communication error occurs during the communication by said first communicating means, communication is performed in accordance with designation of whether transmission of electronic mail by attaching image data by the most common one of image standards or retransmission is to be performed, (e.g. col. 2, line 30 – col. 3, line 62 & col. 4, lines 13 – 67). Furthermore, Applicant admits in prior art whether transmission of electronic mail by attaching image data by the most common one of image standards, (e.g. page 1, line 19 – page 3, line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Applicant's admitted prior art with Joffe for similar reasons stated above, furthermore, it would save time in transmission if a predefined "standard" communication means was established as a backup.

17. As per claim 10, as interpreted by the Examiner, Applicant admits in the prior art that wherein the most common one of image standards is an MH coding system considered to be essential of functional information defined by ITU-T T.30, by which a resolution in a main scan direction is 8 pels/mm, a resolution in a sub-scan direction is 3.85 lines/mm, and an original width is 208 mm of A4 size, (e.g. page 1, line 19 – page 3, line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Applicant's admitted prior art with Joffe for similar reasons as stated above.

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18. As per claim 11, Joffe teaches wherein if the form of connection to said first communicating means is dial-up connection, communication concerning functional information, communication of a text, and communication concerning delivery confirmation are successively performed by a single call, (e.g. col. 7, line 50 – col. 8, line 54).
19. As per claim 12, as interpreted by the Examiner, Joffe teaches wherein if the form of connection to said first communicating means is dial-up connection, communication concerning functional information, communication of a text, and communication concerning delivery confirmation are separately performed by at least two calls, (e.g. col. 2, line 30 – col. 3, line 62 & col. 4, lines 13 – 67 & col. 7, line 50 – col. 8, line 54).
20. As per claim 13, as interpreted by the Examiner, Joffe teaches wherein if the form of connection to said first communicating means is dial-up connection, communication concerning functional information, communication of a text, and communication concerning delivery confirmation are successively performed by a single call or separately performed by different calls, (e.g. col. 2, line 30 – col. 3, line 62 & col. 4, lines 13 – 67 & col. 7, line 50 – col. 8, line 54).
21. As per claim 14, as interpreted by the Examiner, Joffe teaches wherein if the form of connection to said first communicating means is dial-up connection, a line is once disconnected to wait for timeout processing in communication, (e.g. col. 5, line 63 – col. 6, line 50).
22. As per claim 15, as interpreted by the Examiner, Joffe teaches wherein if the form of connection to said first communicating means is dial-up connection, a line is once disconnected to wait for timeout processing in communication, and timeout is selectively verified by recall, (e.g. col. 5, line 63 – col. 6, line 50).

23. As per claim 48, as interpreted by the Examiner, Joffe teaches wherein said wide area network is one of PSTN and ISDN, (e.g. col. 1, lines 14 – 56).

24. Claims 23, 25 – 27, 30 – 33, 34 – 38, 42, 43, 45 – 47, 49 – 67, 71, 72, 82, 84 – 100 are rejected for similar reasons and can be found in the disclosed reference as stated above.

25. Claims 5, 6, 22, 28, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joffe et al. (6600750) (hereinafter Joffe) in view of Applicant's admitted prior art, in further view of Seo (6124947).

26. As per claim 5, as interpreted by the Examiner, Joffe does not specifically teach wherein if during the communication by said first communicating means a communication error occurs in communication of image data and in communication pertaining to delivery confirmation, retransmission is performed by selecting the number of times of retransmission from a plurality of individually preset numbers of times of retransmission including 0, in accordance with the contents of the communication error. Seo teaches wherein if during the communication by said first communicating means a communication error occurs in communication of image data and in communication pertaining to delivery confirmation, retransmission is performed by selecting the number of times of retransmission from a plurality of individually preset numbers of times of retransmission including 0, in accordance with the contents of the communication error, (e.g. col. 5, line 45 – col. 6, line 45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Seo with the combine system of Joffe and Applicant's admitted prior art because it would be more convenient for a user to input exactly how many time to attempt a retransmission if an error were to occur as opposed to having to go through the faxing process manually over and over again.

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27. As per claim 6, as interpreted by the Examiner, Joffe and Seo do not specifically teach wherein no retransmission is performed if the contents of the communication error indicate that there is no destination address.

Examiner takes Official Notice (see MPEP § 2144.03) that " wherein no retransmission is performed if the contents of the communication error indicate that there is no destination address " in a computer networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Applicant's admitted prior art with Joffe because if there is no destination address there can be no retransmission let alone a first transmission without a destination address whether a email address or fax number.

28. Claims 22, 28, 29 are rejected for similar reasons and can be found in the disclosed reference as stated above.

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29. Claims 16 – 20, 24, 39 – 41, 68 – 70, 73 – 80, 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joffe et al. (6600750) (hereinafter Joffe) in view of Applicant's admitted prior art, in further view of Miller, Jr. et al. (6356356) (hereinafter Miller).

30. As per claim 16, as interpreted by the Examiner, Joffe does not specifically teach wherein functional information of a destination apparatus is acquired by communication using one of said first and second communicating means in the past, a database for holding a maximum capability supported by each function is registered or updated, and, if said first communicating means is to communicate data, the data is converted into a standard registered in said database and communicated. Miller teaches wherein functional information of a destination apparatus is acquired by communication using one of said first and second communicating means in the past, a database for holding a maximum capability supported by each function is registered or updated, and, if said first communicating means is to communicate data, the data is converted into a standard registered in said database and communicated, (e.g. col. 3, line 30 – col. 4, line 55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Miller with the combine system of Joffe and Applicant's admitted prior art because it would be more efficient for a system to utilize the functionality of a database that is commonly used for storing information about users and/or devices on a network.

31. As per claim 17, as interpreted by the Examiner, Joffe teaches all that is described above but does not specifically teach wherein whether image data pertaining to said database is to be converted is set for each function item registered in said database. Miller teaches wherein whether image data pertaining to said database is to be converted is set for each function item registered in said database, (e.g. col. 3, line 30 – col. 4, line 55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Miller with the combine system of Joffe and Applicant's admitted prior art because it would be cause less errors in the receiving system if the data was converted to a format that the receiving system could process.

32. As per claim 18, as interpreted by the Examiner, Joffe does not specifically teach wherein if an address of the other party with respect to said first communicating means is input, display related to functional information on an operation panel is switched on the basis of information in said database. Miller teaches wherein if an address of the other party with respect to said first communicating means is input, display related to functional information on an operation panel is switched on the basis of information in said database, (e.g. col. 3, line 30 – col. 4, line 55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Miller with the combine system of Joffe and Applicant's admitted prior art because it would be more convenient for a user to have the system convert the destination number to the address that it is associated with it.

33. As per claim 19, as interpreted by the Examiner, Joffe teaches wherein if a communication error occurs in said first communicating means, said second communicating means communicates image data if communication by said second communicating means is designated and a telephone number of the other party is set. Miller teaches wherein if a communication error occurs in said first communicating means, said second communicating means communicates image data if communication by said second communicating means is designated and a telephone number of the other party is set, (e.g. col. 3, line 30 – col. 4, line 55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Miller with the combine system of Joffe and Applicant's admitted prior art for similar reasons as stated above.

34. Claims 20, 24, 39 – 41, 68 – 70, 73 – 80 and 83 are rejected for similar reasons and can be found in the disclosed reference as stated above.

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35. Claims 21, 44 rejected under 35 U.S.C. 103(a) as being unpatentable over Joffe et al. (6600750) (hereinafter Joffe) in view of Applicant's admitted prior art, in further view of Wolf (6535303).

36. As per claim 21, as interpreted by the Examiner, Joffe teaches all that is described above but does not specifically teach wherein when said first communicating means is to perform communication concerning the functional information, of pieces of functional information defined by ITU-T T.30, functional information pertaining to communication such as a handshake rate, a modem rate, a minimum transmission time, the presence/absence of error correction mode, and the presence/absence of G4 function need not be exchanged. Applicant's admitted prior art teaches wherein when said first communicating means is to perform communication concerning the functional information, of pieces of functional information defined by ITU-T T.30, functional information pertaining to communication such as a handshake rate, a modem rate, a minimum transmission time, the presence/absence of error correction mode need not be exchanged, (e.g. page 1, line 13 – page 3, line 20) and Wolf teaches the G4 function, (e.g. col. 3, lines 14 – 61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Wolf with the combine system of Joffe and Applicant's admitted prior art for similar reasons as stated above.

37. Claim 44 is rejected for similar reasons and can be found in the disclosed reference as stated above.

***Conclusion***

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

39. a. Rupp et al. U.S. Patent No. 6144464 discloses Method and system for modification of fax data rate over wireless channels.

40. b. Rachelson U.S. Patent No. 6157706 discloses Method and apparatus for enabling a facsimile machine to be an e-mail client.

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41. c. Oseto U.S. Patent No. 6097797 discloses Network facsimile apparatus capable of E-mail communications.

42. d. Bloomfield U.S. Patent No. 6025931 discloses Facsimile to E-mail communication system with local interface.

43. e. Saito et al. U.S. Patent No. 6208426 discloses Facsimile communication method and facsimile machine.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is none.

David E. England  
Examiner  
Art Unit 2143

De *DC*



DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
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